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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,380	01/09/2004	Bradford W. Shaw	451490	7804
7590 03/07/2005 Harold V. Stotland Seyfarth Shaw LLP Suite 4200 55 East Monroe Street Chicago, IL 60603-5803			EXAMINER PICKETT, JOHN G	
			ART UNIT 3728	PAPER NUMBER
DATE MAILED: 03/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

8N

# Office Action Summary

Application No.

10/754,380

Applicant(s)

SHAW ET AL.

Examiner

Gregory Pickett

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18 and 20 is/are rejected.
- 7) ☒ Claim(s) 17 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/9/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites the limitation "the first rows and the first columns" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 14 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Riener (US 2,802,411).

Regarding claim 14, Riener discloses a cooking utensil with a base wall **M**, a plurality of evenly spaced first indicia **12** and a plurality of evenly spaced second indicia **13**.

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As to claim 20, inasmuch as the examiner can determine the scope of the claim, Riener discloses line indicia **17**.

3. Claims 14-16 and 18 are rejected under 35 U.S.C. 102(a) as being anticipated by Krupa et al (US 6,450,341).

Krupa et al discloses a cooking utensil with a base wall **20**, a plurality of evenly spaced, circular first indicia **28**, and a plurality of evenly spaced, circular second indicia **26** arranged in alternating columns and rows as claimed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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4. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagandt (US 476,340) in view of Gerard et al (US 3,724,654).

Regarding claims 1, 5, and 7, Wagandt discloses a cooking utensil with a circular base wall **1**, an upstanding peripheral wall **2**, a peripheral flange **3**, and a set of indicia **7** equidistantly disposed on the upper surface of flange **3**.

Wagandt merely lacks a second set of indicia.

Gerard et al discloses indicia **23 & 25** used to discreetly identify the retained items. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the utensil of Wagandt with identifying indicia as taught by Gerard et al in order to identify the individual portions. The examiner notes that identification of the individual slices would have been useful in baked goods to locate items retained within the baked goods, for instance, the baby in a King's Cake.

As to claims 2, 4, and 6, Gerard et al centrally locates the indicia on the retention pockets and it would have been obvious to maintain this central location for the indicia on the utensil of Wagandt-Gerard for aesthetic purposes. Such an arrangement would have the claimed opposed, equidistant relationship.

As to claim 3, concerning the size of the indicia, it would have been an obvious matter of design choice to provide the indicia in differing sizes, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wagandt-Gerard as applied to claim 1 above, and further in view of Riener (US 2,802,411).

Wagandt-Gerard discloses the claimed invention except for the additional indicia on the base wall.

Riener discloses indicia **12 & 13** on the upper surface of the base wall. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the utensil of Wagandt-Gerard with additional indicia as taught by Riener in order to stiffen the base wall.

6. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caputo (US 6,745,660) in view of Gerard et al (US 3,724,654).

Regarding claims 9 and 12, Caputo discloses a utensil 20 with a rectangular base wall 22, an upstanding peripheral wall 24, a peripheral flange 26, and a set of indicia 40 equidistantly spaced on the upper surface of flange 26.

Caputo merely lacks a second set of indicia.

Gerard et al discloses a set of indicia **23 & 25** used to discreetly identify the retained items. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the utensil of Caputo with identifying indicia as taught by Gerard et al in order to identify the individual portions. The examiner notes that identification of the individual slices would have been useful in baked goods to locate items retained within the baked goods, for instance, the baby in a King's Cake.

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As to claim 10, concerning the size of the indicia, it would have been an obvious matter of design choice to provide the indicia in differing sizes, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

As to claim 11, Gerard et al centrally locates the indicia on the retention pockets and it would have been obvious to maintain this central location for the indicia on the utensil of Caputo-Gerard for aesthetic purposes. Such an arrangement would have the claimed opposed, equidistant relationship.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caputo-Gerard as applied to claim 9 above, and further in view of Saleeba (US 4,452,419).

Caputo-Gerard discloses the claimed invention except for the additional indicia on the base wall.

Saleeba discloses indicia **31** on the upper surface of the base wall. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the utensil of Caputo-Gerard with additional indicia as taught by Saleeba in order to stiffen the base wall.

***Allowable Subject Matter***

8. Claims 17 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*for*

Greg Pickett  
Examiner  
4 March 2005



Mickey Yu  
Supervisory Patent Examiner  
Group 3700